

REMARKS

In the Advisory Action dated November 23, 2004, the Examiner refuses to enter the Reply after Final filed on November 12, 2004 because the claim amendments presented therein allegedly raise new issues that require further consideration and/or search, and are not deemed to place the application in better form for appeal. Thus, for purposes of Appeal, claims 1 and 6 are allowed, while claims 2 and 7-12 remain rejected.

Claims 2 and 11 are canceled herein. Claims 7 and 8 are amended to depend from allowed claims 1 and 6. Currently pending claims 9, 10, and 12, in turn, depend from claims 8, 8, and 7, respectively. No new matter is inserted into the application.

Request for Entry into Record

The Examiner is respectfully requested to enter into the record of the present application the Reply after Final filed on November 12, 2004 and the instant Supplemental Reply after Final. Applicants respectfully submit that the cancellation of claims 2 and 11 herein overcomes all outstanding rejections so that the present application is in condition for allowance. As such, claims 1, 6-10, and 12 will be pending and in condition for allowance upon entry of the Reply after Final filed on November 12, 2004 and the instant Supplemental Reply after Final.

New Issues Raised by Claim Amendments

On page 2 of the Advisory Action, the Examiner writes,

Claim 8 [is] amended to recite that the nucleic acid promotes expression and that expression is promoted by said promoter raises new 112 2nd issues in lieu of claim 11 which recites that another promoter controls expression.

Claim 11 is canceled herein. Applicants note that in claim 8, the inventive nucleic acid is inserted upstream from the polynucleotide encoding the protein of interest. Applicants respectfully submit that the cancellation of claim 11 herein precludes any new issues under 35 U.S.C. § 112, second paragraph. Therefore, no new issues which would require further consideration and/or search by the Examiner exist. For this reason, the Examiner is respectfully requested to enter into the record of the present application the Reply after Final filed on November 12, 2004 and the instant Supplemental Reply after Final so that the present application may proceed to allowance.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner maintains the rejection of claims 2 and 7-9 under 35 U.S.C. § 112, first paragraph for allegedly containing subject

matter neither described in, nor enabled by, the specification. Claim 2 is canceled, thus rendering rejection thereof moot. Claims 7-9 no longer depend from claim 2. Thus, the instant rejection is overcome.

Conclusion

Applicants respectfully submit that the above amendments and/or remarks fully address and/or render moot the rejections of record. The present application is in condition for allowance. The Examiner is respectfully requested to issue a Notice of Allowance indicating that claims 1, 6-10, and 12 are allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kristi L. Rupert, Ph.D. (Reg. No. 45,702) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

The applicant(s) hereby petition(s) for an extension of three (3) month(s). An extension of one (1) month(s) was previously requested and paid for on November 12, 2004 in the instant application. Thus, a fee of \$870.00 is required to obtain an additional two (2) month(s) extension.

Appl. No. 09/856,725

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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